

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JESSE ROSS

Appeal No. 2003-1149
Application No. 09/853,540

ON BRIEF

Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1,¹ which is the only claim pending in this application.

We AFFIRM.

¹This claim erroneously has been numbered as "2" in the copy of the claim which appears in the appendix to the Brief.

BACKGROUND

The appellant's invention relates to a method of treating the symptoms of scleroderma. Claim 1 has been reproduced in an appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ross	5,718,721	Feb. 17, 1998
Azar	5,759,200	Jun. 2, 1998
Zhou <u>et al.</u> (Zhou)	5,849,026	Dec. 15, 1998

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Azar or Zhou in view of Ross.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 11) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 12) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claim, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has found that Azar and Zhou each disclose the use of electromagnetic radiation for treating skin diseases, but do not show the claimed frequency, rate, power, shape and sizes of the pulses used in the radiation. However, the examiner has taken the position that one of ordinary skill in the art would have found it obvious to modify either Azar or Zhou by using the values recited in the appellant's claim 1 in view of the teachings of Ross "to improve blood circulation for optimal treatment result" (Answer, page 4).

The appellant has not taken issue with the examiner's conclusion. To the contrary, the appellant's response can only be taken as agreement with the examiner's conclusion, to wit: The appellant has stated on page 4 of the Brief that "[a]pplicant does not contest the anticipatory application of Ross" and, while the rejection is on the basis of lack of patentability over the combined teachings of the references under 35 U.S.C.

§ 103 rather than anticipation under 35 U.S.C. § 102, anticipation is the epitome of obviousness.² The appellant also has offered the opinion, in the sentence bridging pages 6 and 7 of the Brief, that

an individual well versed in the art . . . is fully conversant with the fact that use is made of electromagnetic radiation for treating skin diseases. Thus, the citation of only the '721 patent [Ross] was required in the examination of applicant's application on the issue of patentability.

²In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

This also would indicate that the appellant does not dispute the fact that the invention claimed in the present application is not patentable. Finally, the appellant has argued that the only rejection that should have been made is that of double patenting under 35 U.S.C. § 101, which implies that, as far as we are concerned, the invention claimed in the application is not patentably distinct from that claimed in Ross.

The fact is that the only rejection before us is under 35 U.S.C. § 103,³ and it stands unchallenged by the appellant. This being the case, we shall consider that the combined teachings of Azar and Ross, and of Zhou and Ross, establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and will sustain the rejection.

CONCLUSION

The rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Azar or Zhou in view of Ross is sustained.

The decision of the examiner is affirmed.

³Under the circumstances, we see no need to comment upon the appellant's arguments regarding the propriety of a double patenting rejection under 35 U.S.C. § 101, except to state that it would appear that the steps set forth in the application claim differ from those recited in the two claims in Ross.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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Appeal No. 2003-1149
Application No. 09/853,540

Page 6

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APPEAL NO. 2003-1149 - JUDGE ABRAMS
APPLICATION NO. 09/853,540

APJ ABRAMS

APJ STAAB

APJ McQUADE

DECISION: **AFFIRMED**

Prepared By: Lesley Brooks

GAU: 3700

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DRAFT TYPED: 09 Jan 04

FINAL TYPED: